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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,179	09/25/2003	Massl E. Kiani	MASIMO.376A	7210

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EXAMINER	
BERHANU, ETSUB D	

ART UNIT	PAPER NUMBER
3768	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,179	KIANI ET AL.	
	Examiner	Art Unit	
	Etsub D. Berhanu	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: "responsive" in line 6 should be omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6 and 7-10 recite the limitation "said first internal property" and "said second internal property", respectively, in line 1. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Determining a relationship between a first biological property, a second biological property and a compensated measurement and processing a primary input and a parameter input according to the relationship, as disclosed in the steps of claim 2, is nothing more than implementing a formula, based on a law of nature, to output a measurement. Claiming a method directed soley to using a formula based on a law of nature is considered non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2-6 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Jarman'979 (US Patent No. 5,842,979).

Jarman'979 discloses a monitoring method comprising the steps of: reading a primary input in communication with a first device responsive to a first biological property and a parameter input in communication with a second device responsive to a second biological property (col. 4, lines 47-62); determining a relationship between the first biological property, the second biological property and a compensated measurement, and processing said primary input and said parameter input according to the relationship so as to output a compensated measurement (col. 6, line 29 – col. 7, line 67).

Figure 1 of Jarman'979 further discloses a monitor for compensating a first physiological property using a second physiological property, the monitor comprising: a primary input in communication with a first device 24, a parameter input in communication with a second device 25 and responsive to a second physiological property, compensation means for determining a relationship between compensated measurement values, the first input and second input (Figure 2, elements 230, 240 and 250), a processor 107 configured to output a compensated measurement from the primary input and the parameter input utilizing the compensation relationship (see method discussion above), and information elements 106, 114 and 115. Jarman'979 further discloses that the first internal property comprises blood oxygen levels and that the second internal property comprises HbCO and MetHb (col. 3, lines 63-67). It is noted that the blood oxygen levels determined using the apparatus of Jarman'979, oxyhemoglobin, reduced hemoglobin, carboxyhemoglobin and methemoglobin, are all dependent upon

one another. Jarman'979 also discloses the use of a calibration curve as part of the compensation relationship (col. 5, line 55 – col. 6, line 2 and col. 6, lines 29-45).

Regarding claim 4, it is noted that no weight was given to lines 7-8 "a compensation relationship of said primary input, said parameter input and a compensated measurement;" because it is not part of the structure of the monitor and therefore fail to further limit the structure of the monitor. It is further noted that even if weight were given to lines 7-8 of claim 4, Jarman'979 teaches the compensation relationship as discussed above.

8. Claims 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al.'039 (US Patent No. 5,190,039).

Takeuchi et al.'039 discloses a monitor for compensating a first physiological property using a second physiological property, the monitor comprising: a primary input in communication with a first device and responsive to a first physiological property, a parameter input in communication with a second device and responsive to a second physiological property, wherein the second internal property comprises pH, and a processor configured to output a compensated relationship from the primary input and parameter input using a compensation relationship (col. 7, line 38 – col. 8, line 22).

Regarding claim 4, it is noted that no weight was given to lines 7-8 "a compensation relationship of said primary input, said parameter input and a compensated measurement;" because it is not part of the structure of the monitor and therefore fail to further limit the structure of the monitor. It is further noted that even if weight were given to lines 7-8 of claim 4, Jarman'979 teaches the compensation relationship as discussed above.

9. Claims 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Steuer et al.'136 (US Patent No. 5,372,136).

Steuer et al.'136 discloses a monitor for compensating a first physiological property using a second physiological property, the monitor comprising: a primary input in communication with a first

device and responsive to a first physiological property, a parameter input in communication with a second device and responsive to a second physiological property, wherein the second internal property comprises hematocrit, and a processor configured to output a compensated hematocrit value from the primary input and parameter input using a compensation relationship (col. 11, lines 30-62). Figures 5A through 5D also indicate that primary inputs (first ray and second ray) are used to determine a hematocrit value, and a parameter input (third ray) is then used to determine a corrected hematocrit value. Col. 9, lines 42-50 further disclose that this corrected hematocrit value is used to determine a correct oxygen content concentration.

Regarding claim 4, it is noted that no weight was given to lines 7-8 "a compensation relationship of said primary input, said parameter input and a compensated measurement;" because it is not part of the structure of the monitor and therefore fail to further limit the structure of the monitor. It is further noted that even if weight were given to lines 7-8 of claim 4, Jarman'979 teaches the compensation relationship as discussed above.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 2-6, 9 and 11-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, 9 and 13 of copending Application No. 10/714,526. Although the conflicting claims are not identical, they are not patentably distinct from each other because: any device found to satisfy the limitations disclosed in claim 7 of Application No. 10/714,526 would also meet the requirements of the limitations set forth in claims 3-6, 9 and 12 of the current application; any device found to satisfy the limitations disclosed in claim 9 of Application No. 10/714,526 would also meet the requirements of the limitations set forth in claim 11 of the current application; and any method found to satisfy the limitations disclosed in claim 13 of Application No. 10/714,526 would also meet the requirements of the limitations set forth in claim 2 of the current application, as the claims of the current application are broader than those of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

12. Applicant's arguments with respect to claims 2 and 3 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etsub D. Berhanu whose telephone number is 571.272.6563. The examiner can normally be reached on Monday - Friday (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDB

ERIC F. WINAKUR
PRIMARY EXAMINER